

**REMARKS**

Claims 1-18 are pending in the present application after this amendment adds new claims 14-18. Claims 1, 4, 5, 12, and 13 are amended by this amendment. No new matter is introduced by the amendments and new claims, which find support throughout the specification and figures. In particular, the new claims are supported at least at figure 3A and page 8, line 27, to page 9, line 3 of the specification. In view of the amendments and the following remarks, Applicants respectfully request that the pending claims be allowed.

Claims 1-13 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,835,087 to Herz et al. (hereinafter Herz). Applicants respectfully traverse.

Claim 1 relates to an in-content advertising method in which advertisement information provided beforehand is included in digital contents activated in a user terminal by a user. The method of amended claim 1 includes, *inter alia*, ***activating in a user terminal in a game program by a user the digital contents*** and determining that the digital contents have been activated by the user. In claim 1, the advertising information is automatically selected and retrieved from the advertising server, transferred to the user terminal, and inserted in the digital contents when the digital contents are ***activated in the game program*** in the user terminal by the user

The Examiner's response to the amendment and arguments presented in applicants' most recent amendment is that the amendment relates to a non-functional description, and is therefore not given patentable weight. Without admitting the veracity of this assertion, Applicants herein amend claim 1, and the other independent claims, to recite the feature of activating in a user terminal in a game program by a user the digital contents.

Herz apparently discloses an automatic clipping service that learns to select new articles to match a user's interests (Herz; col. 55, lines 47-50). Herz does not disclose or suggest the advertising information that is selected and retrieved from an advertising server is inserted in the digital contents when the digital contents are activated *in a game program by a user*. The Examiner indicates that the differences in the unamended claims relate to non-functional descriptive material. However, it is respectfully submitted that the news clipping service is fundamentally different from the game program recited herein. The news clipping service relates to a system in which the user is seeking information. (Herz; abstract). In contrast, the present invention relates to users who are operating a game, to whom an advertiser would like to present updated advertisement information. Therefore, the context of the in content advertising is entirely different, and the Examiner's assertion that the game program is non-functional descriptive material is incorrect. The features of the claims relating to game programs are deserving of patentable weight and examination, and since Herz does not disclose or suggest these features, claim 1 is patentable over Herz.

Therefore, for at least this reason, claim 1 is allowable. As claims 2 and 3 depend from allowable claim 1, Applicant further submit that claims 2 and 3 are allowable for at least this reason.

Applicants respectfully submit that independent claims 4, 5, 12, and 13 are not rendered unpatentable by Herz, and are in condition for allowance. As claims 6-11 depend from one of allowable claims 4 or 5, Applicant further submit that claims 6-11 are allowable for at least this reason.

New claims 14, 15, 16, 17, and 18 depend from claims 1, 4, 5, 12, and 13, respectively, and are therefore each allowable for at least the same reasons as their respective base claims are

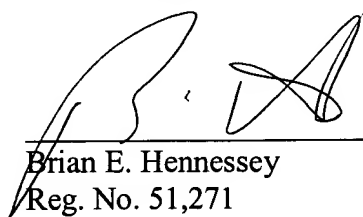
allowable. Additionally, each of the new claims recites that the digital contents include a header including at least a company name and a title; movie data including graphics data; the game program; object data; and a plurality of sets of texture data. It is respectfully submitted that Herz does not disclose digital contents including any of these elements, and in particular does not disclose the digital contents including a game program, as discussed above. Therefore, for at least this additional reason, new claims 14-18 are allowable.

### CONCLUSION

In view of the remarks set forth above, this application is believed to be in condition for allowance which action is respectfully requested. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



Brian E. Hennessey  
Reg. No. 51,271

CUSTOMER NUMBER 026304  
Telephone: (212) 940-6311  
Fax: (212) 940-8986 or 8987  
Docket No.: 100809-16225 (SCEI 18.302)  
BEH:pm